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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/603,490	06/25/2003	Donald E. Weder	8403.930	3552

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EXAMINER
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SIMONE, CATHERINE A

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 04/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/603,490

Applicant(s)

WEDER ET AL.

Examiner

Catherine Simone

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) 14-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-13, drawn to an anti-static sheet of embossed material, classified in class 428, subclass 156.
  - II. Claims 14-28, drawn to a method of wrapping a floral grouping with an anti-static sheet of embossed material, classified in class 53, subclass 397.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product as claimed in Invention I can be used in a materially different process of using that product without the steps of the Group II process i.e. providing a floral grouping having a bloom end and a stem end etc.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Douglas Sorocco on March 2, 2004 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-13.

Affirmation of this election must be made by applicant in replying to this Office action.

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Claims 14-28 stand withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Specification***

2. The amendment filed in parent application, U.S. Serial No. 09/851,184, on October 1, 2002 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The recitation “an amount of water in a range from about 0% to about 92%, and a pH neutralizing agent in a range from about 8% to about 92%” in claim 3 and the recitation “alpha-tridecyl-omega-hydroxy-phosphate” in claim 4 are deemed new matter.

Applicant is required to cancel the new matter in the reply to this Office Action.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. **Claims 3, 4, 5 and 13** are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The recitation “an amount of water in a range from about 0% to about 92%, and a pH neutralizing agent in a range from about 8% to about 92%” in

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claim 3 and the recitation “alpha-tridecyl-omega-hydroxy-phosphate” in claim 4 are deemed new matter. The specification, as originally filed, does not provide support for the invention as is now claimed.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1, 2, 6-8, and 12** are rejected under 35 U.S.C. 102(b) as being anticipated by Yoshimura et al. (3,773,608).

Yoshimura et al. discloses an anti-static sheet of embossed material having a texture and appearance simulating paper (see col. 4, lines 36-42). Regarding **claims 2, 7 and 8**, note the sheet or sheets of material is of polymer film (see col. 12, lines 36-41). Regarding **claim 12**, the sheet of material has a thickness of from about 0.1 mil to about 30 mil. (see col. 11, line 21).

In regards to **claims 1 and 6**, the limitations “made by the process consisting of the steps of: providing a sheet of material having a first and second surface, applying an anti-static coating composition, embossing the sheet of material, printing a pattern and laminating a matte material over the printed pattern etc.” (claim 1) and “wherein the step of embossing the sheet of material, the sheet of material is embossed on a paper to steel roll embosser” (claim 6) are methods of production and therefore do not determine the patentability of the product itself. Process

limitations are given little or no patentable weight. The method of forming the product is not germane to the issue of patentability of the product itself. MPEP 2113.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 3-5 and 13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura et al. (3,773,608) in view of Gust et al. (5,925,447).

Yoshimura et al. discloses an anti-static sheet of embossed material having a texture and appearance simulating paper. However, Yoshimura et al. fails to disclose the anti-static composition comprising a surfactant in a range from about 8 wt% to about 100 wt%, an amount of water in a range of from about 0% to about 92%, and a pH neutralizing agent in a range of from about 8% to about 92%. Gust et al. teaches that it is old and well-known in the art to have an anti-static coating composition having a surfactant in a range from about 8 wt% to about 100 wt%, an amount of water in a range of from about 0% to about 92%, and a pH neutralizing agent in a range of from about 8% to about 92% (see col. 2, lines 50-60 and col. 4, lines 35-40) for the purpose of coating a polymeric film and providing anti-static properties.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the film in Yoshimura et al. with an anti-static coating having a surfactant in a range from about 8 wt% to about 100 wt%, an amount of water

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in a range of from about 0% to about 92%, and a pH neutralizing agent in a range of from about 8% to about 92% as suggested by Gust et al. in order to coat the polymeric film and provide anti-static properties.

9. **Claims 9-11** are rejected under 35 U.S.C. 103(a) as being unpatentable over Yoshimura et al. (3,773,608) in view of Weder (5,921,061).

Yoshimura et al. discloses an anti-static sheet of embossed material having a texture and appearance simulating paper. However, Yoshimura et al. fails to disclose a first decorative item being printed in or out of registry with a second decorative item. Weder teaches that it is old and well-known in the art to have a first decorative item being printed in or out of registry with a second decorative item (see col. 15, lines 33-43) for the purpose of producing a decorative anti-static sheet to be used as a wrapping material.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the film in Yoshimura et al. with a first decorative item being printed in or out of registry with a second decorative item as suggested by Weder in order to produce a decorative anti-static sheet to be used as a wrapping material.

### ***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (571)272-1501. The examiner can normally be reached on 9:30-6:00.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Catherine Simone  
Examiner  
Art Unit 1772  
April 16, 2004



HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

4/16/04